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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,049

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Troels Schonfeldt

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EXAMINER

NICHOLSON, KERI JESSICA

ART UNIT

PAPER NUMBER

3772

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,049	Applicant(s) SCHONFELDT, TROELS	
	Examiner KERI J. NICHOLSON	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/18/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is the initial Office Action based on non-provisional application 10/581,049 filed May 30, 2006, which is a 371 of PCT/DK04/00826 filed November 26, 2004, which claims priority from provisional application 60/528,190 filed December 10, 2003. Foreign priority is also claimed from Denmark Patents 2003 01763 filed November 28, 2003 and 2004 01319 filed August 31, 2004. The Declaration was filed April 2, 2007. An information disclosure statement was filed December 18, 2006 and considered September 3, 2008. A preliminary amendment was filed May 30, 2006 amending the specification and the claims. Claims 3-12, 15, and 18-20 have been amended; claims 1-20 are currently pending.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Abstract

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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3. The abstract of the disclosure is objected to because of the use of the legal phraseology “comprising” and “said”. See MPEP § 608.01(b). Further, it appears that the term “releasable attached” in lines 5 and 7 should be “releasably attached”. Correction is required.

Claim Objections

4. Claims 1, 3, 7-12, 16 and 18 are objected to because of the following informalities: the term “releasable attached” should be changed to be “releasably attached” in order for the claims to be grammatically correct. Further, it appears that “a tap member” in line 10 of claim 1 should be “a tab member”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 7 recites the limitation “said second portion of said adhesive surface”, however, there is insufficient antecedent basis for this limitation in the claim. For examination purposes, “said second portion” has been interpreted to be “said second end portion” as recited in the independent claim 1.

8. Regarding claim 13, the term “suitably” renders the claim indefinite because it is unclear whether the limitation(s) following the term are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 6-12, 15, 16, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schladermundt et al. (GB Patent 904,632).

11. Regarding claims 1, 2, 4, 7, 15, 16, and 18, Schladermundt discloses a layered product for the non-touch application of an adhesive article (adhesive bandage, 10) comprising a cover layer (strip, 12) inseparably attached to an adhesive layer (13) being interposed between a top layer and a bottom layer (wrapper sheet, 20) (page 2, lines 97-109 and 119-130) wherein the bottom layer and the tab member have a release sheet (lamina) releasably attached to a first end portion of the adhesive layer (page 3, lines 25-30). A second end portion of the adhesive layer is releasably attached to a first portion of a tab member (22) which is attached to the top layer and a second portion of the tab member forming a layer situated on the top layer (Fig. 2; page 3, lines 53-68).

12. Regarding claim 3 and 8-10, Schladermundt discloses that the bottom layer and the top layer have a surface area that is larger than the area of the adhesive article, and the top layer and the bottom layer as well as the tab member and the top layer are releasably sealed to each other thereby forming a package containing the adhesive article (Figs. 1 and 5; page 3, lines 81-106).

13. Regarding claims 6 and 20, Schladermundt discloses that the tab member and the top layer in combination with the bottom layer are designed to be used as a non-touch grip for

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pulling apart the top layer and the bottom layer and exposing the adhesive surface of the adhesive article (page 4, lines 33-85).

14. Regarding claims 11 and 12, Schladermundt discloses that more than 85% of the adhesive surface is releasably to the bottom layer and less than 15% of the adhesive layer is releasably attached to the tab member (Fig. 2).

15. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Johns (U.S. Patent 5,840,052). Johns discloses a layered product for the non-touch application of an adhesive article (1) comprising a cover layer (3) inseparably attached to an adhesive layer (5) being interposed between a top layer (7) and a bottom layer (12) which is releasably attached to a first end portion of the adhesive surface such that a second end portion of the adhesive surface is releasably attached to a first portion of a tab member (7b) formed by folding a part of the top layer upon itself such that the tab member and the top layer in combination with the bottom layer are designed to be used as a non-tough grip for pulling apart the top layer and the bottom layer and exposing the adhesive surface of the adhesive article (Fig. 2; column 8, lines 40-55). Johns further teaches that both the top layer, which comprises the tab member, and the bottom layer can be made of two or more layers, one of which is a release layer releasably attached to the adhesive layer (column 8, lines 20-22 and 33-36).

16. Furthermore, with respect to claim 14, the limitation “the tab member is *formed* by folding” is a product-by-process limitation. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 5, 13, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schladermundt as applied to claim 1 above.

19. Regarding claim 5, Schladermundt discloses the invention substantially as claimed, as described above, but fails to teach that the first portion of the tab member, which is releasably attached to the adhesive layer, has a smaller area than that of the second portion of the tab member, which is situated on the top layer. At the time the invention was made, it would have been an obvious matter of design choice to one having ordinary skill in the art to modify the tab of the layered product taught by Schladermundt such that the first portion has a smaller area than the second portion since such a modification would have involved a mere change in the size of the tab. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

20. Regarding claim 13, Schladermundt discloses the invention substantially as claimed, as described above, but fails to teach that the area of the tab member is between 36 mm² and 400 mm². At the time the invention was made, it would have been obvious to one having ordinary skill in the art to modify the layered product taught by Schladermundt such that the tab member has an area between 36 mm² and 400 mm² since it has been held that where the general

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conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

21. Regarding claims 17 and 19, Schladermundt discloses the invention substantially as claimed as described above, but fails to teach that the tab member is inseparably attached to the top layer. At the time the invention was made, it would have been obvious to one having ordinary skill in the art to modify the attachment between the tab member and the top layer of the layered product taught by Schladermundt such that it is an inseparable attachment thus forming an integral part since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KERI J. NICHOLSON whose telephone number is 571-270-3821. The examiner can normally be reached on Monday - Thursday, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached at 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KJN

/Keri J. Nicholson/

Examiner, Art Unit 3772

9/9/2008

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772